

REMARKS

I. Introduction

Applicants and Applicants' representative would like to thank Examiner Vuong again for the indication of allowance of claims 7-14, and for the indication of allowable subject matter recited by claims 5 and 6. In response to the Office Action dated February 22, 2005, Applicants have amended claims 1 and 2 so as to provide the term "facsimile apparatus" with proper antecedent basis. Claim 3 has also been amended so as to address the pending rejection under 35 U.S.C. § 112, second paragraph. New claims 16-27 are added. Support for these amendments can be found, for example, in Fig. 3 and its corresponding section of the specification. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 3, 4 and 6 Under 35 U.S.C. § 112, Second Paragraph

Claims 3, 4 and 6 are rejected under 35 U.S.C. § 112, second paragraph, because the Examiner asserts that it is unclear which element the data converter is converting. As claim 3 has been amended to recite "...and ~~then~~ converting the converted color image data into the data format for monochromatic facsimile transmission, " it is respectfully submitted that the pending rejection under 35 U.S.C. § 112, second paragraph, be withdrawn in view of the foregoing amendment.

III. The Rejection Of Claim 1 Under 35 U.S.C. § 103

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over USP No. 4,900,902 to Sakakibara in view of USP No. 6,204,934 B1 to Minamino and in further view of USP No. 6,621,526 to Yamagishi. Applicants respectfully traverse this rejection for at least the following reasons.

Claim 1 recites a first converting means for converting the data of YCbCr ... into data of RGB format, and a second converting means for converting the data in RGB format being read out by the scanner and the data in RGB format being converted by said first converting means into image data of L*a*b* format.

In the statement of the rejection, it is alleged that Sakakibara discloses a modem 90, a memory card 140 and a reading means (i.e., photoelectric conversion unit 10) for reading data, but admitted that Sakakibara does not disclose or suggest a YCbCr-RGB converter and a RGB-to-L*a*b* converter. The Examiner then concluded that one having ordinary skill in the art would have been motivated to modify the data communication of Sakakibara to include the YCbCr-RGB converter of Yamagishi and the RGB-to-L*a*b* converter of Minamino so as to arrive at the claimed invention. This rejection is respectfully traversed.

In rejecting a claim under 35 U.S.C. §103, the Examiner is required to make a “thorough and searching” factual inquiry and, based upon that factual inquiry, explain *why* one having ordinary skill in the art would have been realistically impelled to modify particular prior art, in this case the methodology of Sakakibara, to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). That burden has not been discharged.

Specifically, it is not apparent and the Examiner has not identified any factual basis upon which to predicate the conclusion that one having ordinary skill in the art would somehow have been realistically led to dramatically deviate from the teachings of Sakakibara by incorporating *two different converters*. Indeed, as is well known, proper §103 rejection must provide a motivation or suggestion *from the prior art* in order to combine the teachings of various references, and may *not* simply pick and choose the claimed elements from various references and combine them to reach the claimed invention. Accordingly, it is respectfully submitted that Sakakibara provides *no* suggestion or motivation for a need of two different converters. In fact, Sakakibara, at best, depicts only a photoelectric conversion unit 10, but provides absolutely no motivation or purpose in its disclosure, either express or implied, for converting the images from the “original sheets” into *color* image data, let alone doing so using the converters of Yamagishi and Minamino in the manner alleged by the pending rejection. This is further evidenced and as readily acknowledged by the Examiner that Sakakibara does not disclose “a YCbCr-to-RGB converter, and an RGB-to-L*a*b* converter,” so that the photoelectric conversion unit 10 of Sakakibara is designed to obtain only *monochromatic* image data, and thereby does not require any converting means for converting any color image data that may be allegedly said to be obtained.

Most importantly, it is respectfully submitted that the cited prior art does not discuss or even recognize the *specific* connection of the converting means recited by claim 1. Specifically, the rejection has not provided any requisite objective evidence from the cited prior art in support of the argument that the RGB- L*a*b* converter 1 of Minamino has *two inputs*; namely one input for retrieving data from the scanner Sc *and* another input for reading data from the YCrCb- RGB conversion circuit 51/52 of Yamaguchi. That is, Minamino only discloses that the RGB

data is read from the scanner Sc and converted into L*a*b* data by the L*a*b* converter 1, but does not provide any suggestion that the RGB data converted by the alleged first converting means (i.e., the YCbCr-RGB conversion circuit 51/52 of Yamagishi) is also converted into L*a*b* image data by the L*a*b* converter of Minamino. In other words, even assuming *arguendo* that the applied references can be combined, the claimed invention still would not be obtained, because the proposed modification has failed to demonstrate the *inter-relationship* between the RGB- L*a*b* converter 1 of Minamino and the YCrCb-RGB conversion circuit 51/52 of Yamaguchi.

Absent this teaching, it is respectfully submitted that the alleged motivation for making the combination is not derived from the prior art, but rather, inadvertently from the Applicants' disclosure. As such, it is submitted that the pending rejection selects elements from various references and combines them without the requisite suggestion *from the prior art* that the proposed combination is desirable. In other words, the proposed combination is based *solely* on improper hindsight reasoning, utilizing Applicants' specification as a guide to reach the claimed invention. At best, the rejection shows only that the *individual* elements (a RGB- L*a*b converter *or* a YCrCb-RGB conversion circuit) of the claimed invention are known without providing a *prima facie* showing of obviousness that the *combination* of elements (a RGB- L*a*b converter *and* a YCrCb-RGB conversion circuit) is known or suggested.

In this regard, it is respectfully submitted that the alleged motivation on page 4, lines 1-8 of the outstanding Office Action is also improper, because it improperly assumes that Sakakibara requires a large consumption of paper, so that the proposed modification would "save a lot of paper by not having to print the received image data (see, page 4, lines 4-5 of Office Action)."

However, it should be noted that the data communication apparatus of Sakakibara does not require any printing, so that the alleged motivation is not applicable to Sakakibara. Even assuming *arguendo* that the alleged motivation is proper, the data communication apparatus of Sakakibara is designed to receive the character codes and image data retrieved from the photoelectric conversion unit 10 for transmission via the modem 9 and NCU 10. Accordingly, the alleged motivation asserted in the Office Action for making the proposed modification is already achieved by the prior art because there is not a need for printing the image data, thus leaving the proposed motivation as insufficient rationale for making the modification.

As a final note, it should be noted that if it was necessary to retrieve color image data from the scanner of Sakakibara or Minamino as suggested by the pending rejection, one could simply incorporate a *single* converter rather than *two* different converters so as to reduce the size of the alleged all-in-one device constructed in the pending rejection.

For all of the foregoing reasons, it is respectfully submitted that the pending rejection does *not* provide any factual basis upon which to conclude that one having ordinary skill in the art would have been motivated to deviate from the data communication apparatus of Sakakibara by combining the applied prior art to arrive at the claimed invention. *Teleflex Inc. v. Ficosa North America Corp.*, *supra*; *In re Lee*, *supra*. Upon given due consideration to the potent indium of nonobviousness argued *supra*, the conclusion appears inescapable that one having ordinary skill in the art would *not* have found the claimed invention *as a whole* obvious within the meaning of 35 U.S.C. §103. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Applicants, therefore, submit that the imposed rejection of claim 1 under 35 U.S.C. §103 for obviousness predicated upon the acknowledged prior art be withdrawn.

IV. **The Rejection Of Claims 2-3 Under 35 U.S.C. § 103**

Claims 2-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakakibara in view of Minamino and Yamagishi, and further in view of USP No. 6,809,836 to Nobuta. As claims 2-3 are also rejected in view of the proposed modification of Sakakibara in view of Minamino and Yamagishi, it is respectfully submitted that claims 2-3 are patentable over the cited prior art for reasons discussed above with respect to claim 1.

V. **All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 1-3 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

VI. **Conclusion**

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Application No.: 09/942,028

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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